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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/691,023 | 10/21/2003 | John R. Hacker | 758.924USD1 | 5000 |

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Atten: Julie R. Daulton
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EXAMINER

SAVAGE, MATTHEW O

| ART UNIT | PAPER NUMBER |
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1724

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,023

Applicant(s)

HACKER ET AL.

Examiner

Matthew O Savage

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-21-03.
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Applicant's election with traverse of species 1 and subspecies A in the reply filed on is acknowledged. The traversal is on the ground(s) that the application contains only four species corresponding with the number of filter head designs as opposed to ten species of filter head/filter configurations as specified in the restriction requirement. This is not found persuasive because each combination of filter head and filter constitutes a separate species. However species 1 and 2 shown in FIGS. 1-4 will be examined together in order to expedite examination of this application.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Teitz.

With respect to claim 28, Teitz discloses a method of using a liquid filter assembly including:

- (a) providing a single piece filter head 10 capable of operably receiving, separately, both a spin-on canister filter 51 and a cartridge filter 41;
 - (i) the spin-on canister filter including a single-use housing holding a non-replaceable filter element (see FIG. 2); and
 - (ii) the cartridge filter including a re-usable bowl holding a replaceable filter

element (see FIG. 1);

(b) operably installing one of the spin-on canister filter and the cartridge filter onto the filter head to provide a filter assembly with an installed filter and leaving an uninstalled filter uncolmected to the filter head;

(c) after operably installing one of the spin-on canister filter and the cartridge filter onto the filter head to provide a filter assembly with an installed filter, removing the installed filter and then

(d) operably installing the uninstalled filter onto the filter head (see lines 17-26 of col. 1).

Concerning claim 29, Teitz discloses:

(a) the step of operably installing one of the spin-on canister filter and the cartridge filter onto the filter head including threadably connecting the filter head to one of the spin-on canister filter and the cartridge filter (e.g., via component 21); and

(b) operably installing the uninstalled filter onto the filter head includes threadably connecting the filter head to the uninstalled filter.

As to claim 30, Tietz discloses:

(a) the step of providing a filter head includes providing equipment (e.g., an automobile) including anengine having a lubrication system, the equipment including the filter head (see lines 7-9 of col. 1).

Concerning claim 31, Tietz discloses:

- (a) the step of removing the installed filter includes removing the spin-on canister filter from the filter head (e.g., the original equipment filter, see lines 18-20 of col. 1);
- (b) the step of operably installing the uninstalled filter onto the filter head includes installing the cartridge filter onto the filter head (see lines 20-26 of col. 1); and then
- (c) further comprising a step of removing the replaceable filter element from the re-usable bowl and operably installing a second, new filter element into the re-usable bowl to provide a refurbished cartridge filter (see lines 20-26 of col. 1); and then
- (d) operably installing the refurbished cartridge filter onto the filter head (see lines 24-29 of col. 2).

Claims 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Projahn et al

With respect to claim 28, as best understood Projahn disclose a method of using a liquid filter assembly including:

- (a) providing a single piece filter head 17 capable of operably receiving, separately, both a spin-on canister filter 72 (see FIG. 3) and a cartridge filter 11 (see FIG. 1);
 - (i) the spin-on canister filter including a single-use housing holding a non-replaceable filter element; and
 - (ii) the cartridge filter including a re-usable bowl 12 holding a replaceable filter element (see FIG. 1);

(b) operably installing one of the spin-on canister filter and the cartridge filter onto the filter head to provide a filter assembly with an installed filter and leaving an uninstalled filter uncolmected to the filter head;

(c) after operably installing one of the spin-on canister filter and the cartridge filter onto the filter head to provide a filter assembly with an installed filter, removing the installed filter and then

(d) operably installing the uninstalled filter onto the filter head.

Concerning claim 29, as best understood, Projahn et al disclose:

(a) the step of operably installing one of the spin-on canister filter and the cartridge filter onto the filter head including threadably connecting the filter head to one of the spin-on canister filter and the cartridge filter (e.g., via component 21); and

(b) operably installing the uninstalled filter onto the filter head includes threadably connecting the filter head to the uninstalled filter.

As to claim 30, as best understood, Projahn et al disclose:

(a) the step of providing a filter head includes providing equipment (e.g., an automobile) including an engine having a fuel system, the equipment including the filter head.

Concerning claim 31, as best understood, Projahn et al disclose:

(a) the step of removing the installed filter includes removing the spin-on canister

filter from the filter head (see FIG. 3);

(b) the step of operably installing the uninstalled filter onto the filter head includes installing the cartridge filter onto the filter head (see FIG. 1)); and then

(c) further comprising a step of removing the replaceable filter element from the re-usable bowl and operably installing a second, new filter element into the re-usable bowl to provide a refurbished cartridge filter (see FIGS. 1-2); and then

(d) operably installing the refurbished cartridge filter onto the filter head.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Projahn et al.

Regarding claim 32, Projahn et al. disclose:

(a) the step of providing a single piece filter head includes providing the filter head being a single, integral piece having a center tube 47 (see FIG. 1), an outer tube 54, a first liquid flow 50 port, and a second liquid flow port (e.g., surrounded by part 47); the outer tube circumscribing the center tube; the outer tube being defined by a continuous exterior outermost wall;

(i) the outer tube defining an end, an outer tube end port at the end, and an outer tube flow passageway extending between and in fluid

communication with the first liquid flow port and the outer tube end port;

(A) the outer tube further including an outer tube threaded region 44; and

(ii) the center tube defining a center tube flow passageway and a center tube end port; the center tube flow passageway extending between and in fluid communication with the center tube end port and the second liquid flow port;

(A) the center tube projecting outwardly from the end of the outer tube; the filter head capable of operably receiving, separately, both the spin-on canister filter (see FIG. 3) and the cartridge filter (see FIG. 1);

(b) the received filter having a filter threaded region 45 threadably engaged to the outer tube threaded region to define a threaded connection;

(ii) the received filter being in liquid flow communication with the outer tube end port and the center tube end port;

(c) a first seal arrangement 44; the first seal arrangement oriented to form a first seal to inhibit leakage between the outer tube flow passageway and the received filter;

and

(d) a second seal arrangement 27; the second seal arrangement oriented to form a second seal to inhibit leakage between the center tube flow passageway and the received filter.


Projahn et al fail to specify the threaded connection having a cross-sectional thickness no greater than 10 mm, however, such a modification would

Art Unit: 1724

have been obvious in order to optimize the tensile strength of the threaded connection for a given application.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.


Matthew O Savage
Primary Examiner
Art Unit 1724

mos
October 28, 2004